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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IMED GHARSHALLI and DANIEL E. SHEARER

Appeal 2009-012500
Application 10/092,333
Technology Center 2600

Before ALLEN R. MacDONALD, KRISTEN L. DROESCH and
GREGORY J. GONSALVES, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134(a) from a non-final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Exemplary independent claim 1 under appeal reads as follows:

Claim 1. A method for controlling a parameter of at least one signal, including the steps of:

receiving a desired command signal from at least one control input;

determining a potential condition for receiving an undesired command signal from at least one other control input;

adjusting a parameter of an undesired command signal received from the at least one other control input in response to the potential condition; and

delivering the desired command signal and the undesired command signal to at least one output.

Rejections

1. The Examiner rejected claims 1-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. The Examiner rejected claims 1-4, 8-12, 14, 15, 17, and 18 under 35 U.S.C. § 102(e) as being anticipated by Brandt (US 6,854,554 B2).
3. The Examiner rejected dependent claim 16 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Brandt and Kim (US 2003/0060906 A1).

Appellants' Contentions

35 U.S.C. § 101 Rejection

1. At page 12 of the Appeal Brief, Appellants contend that the Examiner erred in rejecting claims 1-20 as being directed to non-statutory subject matter because:

In the Office Action dated April 4, 2007 ("the April 2007 Office Action"), the Examiner, for the first time during prosecution, rejected claims 1-20 under 35 U.S.C. §101 alleging that the "signal" of claims 1, 4-8, and 14-20 is an abstract idea. Office Action at lines 9-12, page 2. Seemingly, the Examiner is asserting that (i) a "signal" is not a physical object and (ii) the claimed subject matter is not a practical application thereof. The Examiner, however, has not provided any legal or factual basis to support this allegation.

35 U.S.C. § 102(e) Rejection

2. Appellants repeatedly contend that the Examiner erred in rejecting claims 1-4, 8-12, 14, 15, 17, and 18 under 35 U.S.C. § 102(e) because Brandt does not disclose changing a parameter after it has been set. See for example:

Brandt does not disclose changing a parameter after it has been set. (App. Br. 15).

Applicant submits that column 5, lines 52-67 of Brandt discloses setting parameters, including deadband, *prior to use* and, after the parameters are set, they are not subsequently changed. (App. Br. 17).

Brandt does not disclose "adjusting" a parameter merely by mentioning that parameters can be set by a user prior to use by changing software.

(App. Br. 17).

Brandt does not disclose "modifying" a parameter merely by mentioning that parameters can be set by a user prior to use by changing software. As set forth above, changing software replaces one parameter with another and does not change a parameter.

(App. Br. 18).

3. Also, Appellants contend that the Examiner erred in rejecting claims under 35 U.S.C. § 102(e) because “[t]he Examiner unreasonably construes at least independent claims 1, 8, and 18 by alleging that Brandt's setting of parameters prior to use is the same as the steps and elements recited in claims 1, 8, and 18. (App. Br. 20). Further, Appellants contend

The Examiner incorrectly asserts that the *settable* parameters disclosed by Brandt are equivalent to *adjusting* a parameter of an undesired command signal, as recited in claim 1. This assertion is not consistent with the interpretation of the phrase in context of Appellant's specification and in view of the plain meaning of the phrase in light of the other phrases in the method of claim 1 (e.g., receiving and determining steps). The same problem resonates to other independent claims 8 and 18 and the Examiner's application of the cited art. The Examiner ignores reasonable interpretations of Appellant's claim terms, such as adjusting a parameter of an undesired command signal received from the at least one other control input in response to the potential condition, as recited in claim 1, in the context of not only the specification, but the known meaning in the art.

(App. Br. 20-21).

35 U.S.C. § 103(a) Rejection

4. Additionally, Appellants contend that the Examiner erred in rejecting claim 16 under 35 U.S.C. § 103(a). (App. Br. 21-23).

Issue on Appeal

Whether the Examiner has erred in rejecting claims 1-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter?

Whether the Examiner has erred in rejecting claims 1-4, 8-12, 14, 15, 17, and 18 as being anticipated and claim 16 as being obvious because Brandt and Kim fail to teach or suggest the disputed limitations?

ANALYSIS

We have reviewed the Examiners' rejections in light of Appellants' contentions that the Examiner has erred.

As to Appellants' above contention 1, we agree. The Examiner's rejection provides no explanation as to why a claim which recites process steps and non-abstract physical elements (i.e., "control input", e.g., joystick or lever) is directed to non-statutory subject matter on the sole basis that the claim also recites an abstraction (i.e., "signal") as a portion of the claim.

As to Appellants' other contentions, we disagree with Appellants' conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner.

Further as to above contentions 2 and 3, we note that Appellants' claimed "adjusting" and "modifying" were added by an amendment on December 12, 2005 when the terms were substituted for the term "controlling" in the originally filed claims. We do not find these added terms in Appellants' application as filed. Therefore these new terms are mere substitutes for the claim term they replace and rely on the same support in Appellants' Specification. Appellants' Specification discloses that equations or look-up tables can be used to determine how to control the parameters. (Spec. ¶¶ [16] and [21]). An artisan would recognize that the use of such equations or look-up tables means that while parameter settings are different for different control inputs, parameter settings are fixed for a given input and that given input will always produce the same parameter according to the equation or look-up table. That is, just as Appellants argue for Brandt, for a given input Appellants' claimed parameter is set prior to use and is not subsequently changed. Further, just as the Examiner found in Brandt, as Appellants given inputs are different over time, the parameter produced by the equation is different for each different input. However, Appellants' parameter will be "set prior to use" just as in Brandt.

Further as to above contention 4, we note that Brandt, at column 4, lines 56-59, explicitly suggests using the same time lapse limitation found in Appellants' claim 16.

CONCLUSIONS

- (1) Appellants have established that the Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 101.
- (2) The Examiner has not erred in rejecting claims 1-4, 8-12, 14, 15, 17, and 18 as being anticipated under 35 U.S.C. § 102(e).
- (3) The Examiner has not erred in rejecting claim 16 as being unpatentable under 35 U.S.C. § 103(a).

DECISION

The Examiner's §101 rejection of claims 1-20 is reversed.

The Examiner's §102 and §103 rejections of claims 1-4, 8-12, and 14-18 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

ELD